

REMARKS

Summary

This Amendment is responsive to the final Office Action mailed on June 25, 2004. Withdrawn claims 22-42 are cancelled. Claims 2, 3, 5-21, 58, 59, 61 and 62 are pending. Claims 2, 3, and 59 have been withdrawn from consideration.

The Examiner has acknowledged that claim 58 is a generic claim. Applicants respectfully submit that upon the allowance of generic claim 58, Applicants will be entitled to consideration of claims to additional species (i.e., withdrawn claims 2, 3, and 59) which are dependent on or otherwise contain all the limitations of the generic claim.

The Examiner has indicated that claims 9, 11, and 21 contain allowable subject matter.

Claims 5, 6, 8, 10, 12-20, and 58 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Harris (US 4,456,834).

Claims 5, 7, 12-14, 58, 61 and 62 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Guillot (US 5,749,143).

Applicants respectfully traverse these rejections in view of the comments which follow.

Description of Substance of June 23, 2004 Interview

Applicants acknowledge receipt of the Interview Summary attached to the Office Action which summarizes the June 23, 2004 interview. On June 23, 2004 the Examiner telephoned to determine whether the Applicants would accept an amendment to claim 58 which incorporated the subject matter of either of claims 9 or 11, in order to overcome rejections based on Harris and Guillot which would be forthcoming in the next Office Action. Applicants indicated to the Examiner that such an Amendment was not agreeable without first studying the Examiner's reasons for such

rejections in detail. Therefore, Applicants requested that the Examiner issue a further Office Action.

Discussion of Harris

Claims 5, 6, 8, 10, 12-20, and 58 stand rejected as being anticipated by Harris. This rejection is respectfully traversed. An anticipation rejection requires that each and every element of the claimed invention as set forth in the claim be provided in the cited reference. See *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186 (CA FC 2003), and cases cited therein. As discussed in detail below, Harris does not meet the requirements for an anticipation rejection.

Harris discloses a method for manufacturing a proximity switch having an induction coil and an oscillator circuit. The method comprises providing an end cap for receipt of the coil, positioning the coil in the end cap, and potting the coil in the end cap by filling the end cap with a curable potting compound, thereby forming an easily handled unit, and subsequently connecting the coil to the oscillator circuit and mounting the end cap unit on a housing which encloses the oscillator circuit (Col. 1, lines 25-35).

As can be seen from Figure 1 of Harris, the end cap 14 closes one end of the housing 10 and mounts an induction coil 16 (Col. 2, lines 25-26). The induction coil is the sensor element of the proximity switch. Therefore, the end of the housing which is closed by the cap 14 corresponds to a front end of the housing. A metal cap 26 closes the other end of the housing 10 of Harris (Col. 2, lines 33-35).

With the method disclosed in Harris, the coil 16 is positioned in the end cap, potted in the end cap, and the end cap is then mounted on the housing. The assembly of substrate 18, carrier 20, and end cap 14 is then treated in a certain way, as described at Column 3, lines 8-33. The end cap unit 14 is then

introduced into the corresponding end of the housing 10, the switch is filled with epoxy resin and afterwards the metal cap 26 is put in place (Col. 3, lines 34-40). Therefore, the housing 10 disclosed in Harris is not a housing with a closed front end and an open rear end. In Harris, both ends of the housing 10 are open ends that are capped with caps 14 and 26.

In contrast, the housing set forth in Applicants' claims is provided with a closed front end an open rear end and the open rear end is capped with a cap.

In addition, the end cap unit 14 of Harris is not introduced into the open rear end of the housing as claimed by Applicants, but rather the open front end of the housing. However, assuming for the sake of argument that the end of the housing 10 which is capped with the metal cap 26 is considered to be the front end of the housing as assumed by the Examiner, Harris discloses that the metal cap 26 is mounted to the housing 10 as a last step.

Therefore, there is no provision in Harris of a housing having a closed front end and an open rear end as claimed by Applicants.

Further, in Harris, the moulding compound is poured into the end of the housing which is subsequently closed by the end cap 26 (Col. 3, lines 38-40), which the Examiner indicates is the front end of the housing 10.

Harris does not disclose or remotely suggest that a housing with a closed front end and an open rear end is provided, as claimed by Applicants. Contrary to Applicants' claimed invention, Harris discloses a sensor housing with an open front end and an open rear end.

Further, Harris does not disclose or remotely suggest that the carrier and the molding compound are introduced into the open rear end of a housing having one open end and one closed end, as claimed by Applicants. In contrast, the carrier of Harris is inserted into one open end of the housing and the moulding compound is introduced into the other open end of the housing.

In other words, with Applicants' claimed invention, the carrier and the moulding compound are both introduced into the same end of the housing (i.e., the open rear end). In contrast, in Harris, the carrier is inserted into one open end, which is capped, and then the moulding compound is introduced into the opposite open end, which is also capped. Accordingly, the method for fabricating a sensor as disclosed in Harris is substantially different than that claimed by Applicants.

As Harris does not disclose each and every element of the invention as claimed, the rejections under 35 U.S.C. § 102(b) are believed to be improper, and withdrawal of the rejections is respectfully requested. See, *Akamai Technologies Inc., supra*.

Discussion of Guillot

Claims 5, 7, 12-14, 58, 61 and 62 stand rejected as being anticipated by Guillot. This rejection is respectfully traversed. An anticipation rejection requires that each and every element of the claimed invention as set forth in the claim be provided in the cited reference. See *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186 (CA FC 2003), and cases cited therein. As discussed in detail below, Guillot does not meet the requirements for an anticipation rejection.

Guillot discloses a process for forming a module to be mounted on a printed circuit board. This process comprises the steps of providing a cap having at least one notch on a side wall thereof, filling the cap with a pre-selected amount of encapsulant and placing an electrical assembly in the cap filled with the pre-selected amount of encapsulant (Col. 9, lines 49-60).

The cap 20 of Guillot can be considered to be a housing. However, Guillot does not disclose or remotely suggest that the open rear end of cap 20 is capped with another cap. The Examiner indicates that a cap 16 is disclosed in Guillot. The element 16

shown in Figures 1A and 1B of Guillot is disclosed as being a socket or printed circuit board (Col. 4, lines 66-67) which is not involved in the manufacturing process for the forming of a module.

Therefore, Guillot does not disclose or remotely suggest capping the open rear end of the housing with a cap, as claimed by Applicants.

As Guillot does not disclose each and every element of the invention as claimed, the rejections under 35 U.S.C. § 102(b) are believed to be improper, and withdrawal of the rejections is respectfully requested. See, *Akamai Technologies Inc.*, *supra*.

Applicants respectfully submit that the present invention is not anticipated by and would not have been obvious to one skilled in the art in view of Harris or Guillot, taken alone or in combination with any of the other references of record.

Withdrawal of the rejections under 35 U.S.C. § 102(b) is therefore respectfully requested.

Further remarks regarding the asserted relationship between Applicants' claims and the prior art are not deemed necessary, in view of the above discussion. Applicants' silence as to any of the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection.

Conclusion

In view of the above, the Examiner is respectfully requested to reconsider this application, allow each of the presently pending claims, and to pass this application on to an early issue. If there are any remaining issues that need to be addressed in order to place this application into condition for allowance, the Examiner is requested to telephone Applicants' undersigned attorney.

Respectfully submitted,



Douglas M. McAllister
Attorney for Applicant(s)
Registration No. 37,886
Law Office of Barry R. Lipsitz
755 Main Street
Monroe, CT 06468
(203) 459-0200

ATTORNEY DOCKET NO.: HOE-609

Date: August 5, 2004